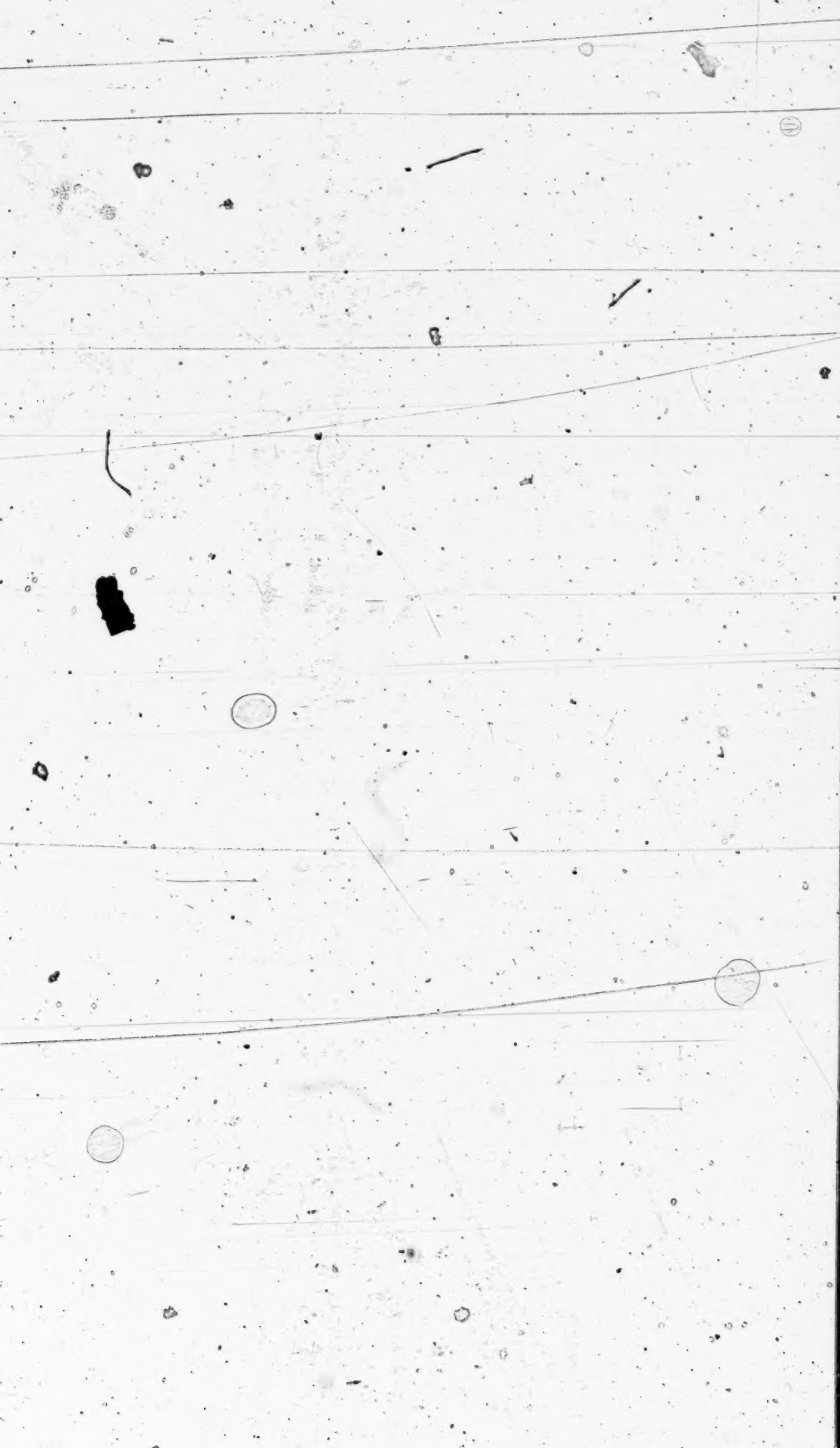

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IN THE

Supreme Court of the United States

October Term, 1941

No. 720

MILCOR STEEL COMPANY,

Petitioner,

vs.

GEORGE A. FULLER COMPANY, NEFF LATHING COMPANY, INC., and CONVER STEEL & WIRE COMPANY, INC.,

Respondents.

PETITION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

TRUMAN SUNDERLAND SAFFORD,

Attorney.

INDEX

	PAGE
FORMAL PETITION FOR LEAVE TO PRESENT BRIEF AMICUS CURIAE	1
ARGUMENT:	
The Issue Which Affects the Public Interest	2
Protection for Inventor or Infringer	3
Decision Below Begets Abuse Which Courts Have Fought	4
Patents and Monopoly	5
Proper Function of Patent System	8
No Grant of Monopoly	9
Patents Not Reward for Inventor	10
Need for Constructive Reform	12
CONCLUSION	13

CONSTITUTION CITED

Art. I, Sec. 8	10

STATUTES CITED

R. S. Sec. 4916 (U. S. C., Title 35, Sec. 64)	6
R. S. Sec. 4917 (U. S. C., Title 35, Sec. 65)	2, 3, 4, 8
R. S. Sec. 4922 (U. S. C., Title 35, Sec. 71)	3, 8
R. S. Sec. 4934 (U. S. C., Title 35, Sec. 78) amended by Act of February 14, 1927	4

TEXT BOOKS CITED

Robinson on Patents, § 640-652, pp. 278-94	3
Deller's Edition of Walker on Patents, § 165, p. 770	4, 9

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PETITION FOR LEAVE TO FILE BRIEF AMICUS CURIAE

Now comes your petitioner, Truman Sunderland Safford, and, representing:

1) That he is a member of the bar of this Court, practicing especially in patent matters;

2) That he has no interest in this litigation and no connection or relation with or to any of the parties or their attorneys, excepting only his general interest and relation as a member of the patent bar and of the public interested in efficient administration of the patent system;

3) That the construction of the disclaimer statute adopted by the Court below will, if sustained, have far-reaching adverse effects on the public interest;

4) That the defendant may consider that such a brief in the public interest would be adverse to its immediate interest in the outcome of this litigation and, therefore, his attorney may feel that he should not consent to the filing of a brief *amicus curiae;*

your petitioner, therefore, begs leave of this Court to file a brief *amicus curiae* in the above entitled case.

The Issue Which Affects the Public Interest

The issue on which it is submitted that the public interest should be brought out is whether a statutory disclaimer under the provisions of R. S. 4917 (U. S. Code, Title 35, sec. 65) may narrow the patent by further definition expressed in the disclaimer or may only cancel entire claims outright.

The court below has held the latter:

> "The patentee files it because he fears that the claim as it stands may be invalid and hopes in this way to sustain it. This should never have been countenanced, for the original claims in this way become mere traps. The art has the same reason as the patentee for supposing that they are invalid, and it may in fact act in reliance upon that supposition, as it is altogether justified in doing. The disclaimer, if it proves successful, will not only disappoint that reliance for the future, but it will make the art infringe *ab initio* so far as it may have disregarded the claim. If it be urged that this should be a defence, personal to any particular infringer, which he should be compelled to prove, we answer that the claim by hypothesis has been withdrawn as invalid or doubtful; the patentee has forfeited it; and that nobody should be held accountable for infringing it. If a new claim is to take its place, the Patent Office should examine how far the art may have acted in reliance upon the invalidity of the old claim, and what excuse the patentee had for claiming so much originally. The new claims are in truth no less than reissued claims.

Moreover, like reissues, they should certainly not be retroactive. Patentees do not need such protection. If they succeed in getting a broad claim whose validity they doubt, they should protect themselves by asking for more contracted claims; and if these are denied, good faith requires them to make their contest then and there; or later by reissue, if some subsequent excuse for their original failure really turns up. If they do get narrow claims and the broad ones turn out to be invalid, the public will not have been misled, for the narrow claims will stand as a warning as to which everyone must take his chances."

This holding appears to be contrary to the original intent of the disclaimer statute and to defeat the remedial purpose of Congress in enacting both R. S. 4917 (U. S. C., Title 35, sec. 65) and R. S. 4922 (U. S. C., Title 35, sec. 71). The wording of Sec. 4922 is particularly significant. It permits suit to be brought on a too broad patent if *any part* of what was originally patented is "bona fide his own, if it is a material and substantial part" and if it is "definitely distinguishable" (not distinguished). In such case *disclaimer* (not reissue) was required. (See Robinson on Patents § 640-652, pp. 278-294).

Quite apart from any historical reasoning, however, the effect of the decision below, under present day conditions, is contrary to recognized public policy which has given new trends to decisions of this court as well as other courts of the land.

Protection for Inventor or Infringer

It must be assumed in considering the effect of a disclaimer, that the patentee did not know of the invalidity of his original claim when his patent was granted. To have applied for and accepted a patent with knowledge of the invalidity of its claims would be a fraud and deceit, which by express provision of the statute would make the disclaimer invalid. (Robinson on Patents § 642, p. 281.) Un-

due breadth in a patent can be cured by disclaimer only if it occurred,

> " . . . without any fraudulent or deceptive intention" (R. S. 4917, U. S. C., Title 35, sec. 65).

The question at issue, therefore, is whether a patentee, having believed that he was validly entitled to a broad claim and having been supported in that belief by the investigation and decision of the Patent Office, should be required to "forfeit" all redress for past infringement and to go back to the Patent Office and begin his litigation all over again with an application for reissue of his patent; and, if he should not care to undertake that additional burden of expense and uncertainty, to be required to forfeit that part, or all, of his novel and patentable invention which he had not separately claimed by subsidiary claims in his original patent; or should the burden be put upon the infringer who, if he were not wantonly defying a patent of the United States, must have known of the defect in the patent and, therefore, have been in a position to determine the proper scope, if any, of the patent.

Decision Below Begets Abuse Which Courts Have Fought

The effect of the decision below is to require an inventor, as the price of any satisfactory protection, to obtain in his patent a multiplicity of claims, a practice which courts and Patent Office have consistently condemned as a major obstacle to proper administration of justice in patent law. [See Deller's Edition of Walker on Patents § 165, p. 770], and which Congress has attacked directly by a change in fees (Act of Feb. 14, 1927) to tax extra claims (R. S. 4934, U. S. C., Title 35, Sec. 78).

No patentee can possibly know everything that had been done before his invention nor even everything that had been described in printed publications. No matter how

many years one spends in searching, no matter how many thousands of dollars one spends to employ the most skilful searchers for every language, there will always remain some possibility that an anticipation of his invention has been overlooked or not yet reached. The law presumes—for the protection of the man who had knowledge of the matter before the patentee's invention—that the patentee knew everything which had been done in the same "useful art" before his own invention; but obviously that is a mere legal fiction.

The disclaimer statute was remedial, to lighten the burden of ~~that fiction.~~ If that remedy is to be denied to the patentee, the prudent inventor has but one alternative; to try to foresee every possible contingency and to write a separate claim for each. The number of necessary claims would be limited only by the number of possible variations in what might have been known before him.

Such multiplication of claims as this would require has been condemned by the Patent Office and the Courts because it multiples the labor of public officers and the cost to the government in adjudicating patents and patent applications. It has been equally severely condemned because of the unreasonable burden it throws upon those of the public who, in trying to avoid infringement, must determine the effect of the patent. It should be equally condemned for the useless waste of energy and cost to the patentee in building up hypothetical cases and drafting claims to define what would be his true and novel invention in each such case.

Patents and Monopoly

Patents have been under attack in recent years by some who have assumed that they are instruments of monopoly—in defense of entrenched power. To the extent that that may be true it is the very antithesis of their purpose and it demands reform; but even if it is assumed to be true it

is not a criticism of patents as such nor of our patent system, but of its administration. The decision below will aggravate or create the condition which warrants such criticism.

The history of every branch of the law has shown an alternation between accumulation of more or less useless encumberance of expensive formal requirements and forensic calisthenics (often adopted in good faith to remedy lesser evils) and then reforms by which procedure is simplified and costs reduced. It may be likened to a boat long in the water, gradually accumulating barnacles and marine growth, until it is barely useful to carry cargo, finally being hauled out on the beach and scraped clean for a new voyage.

So with the patent law. It is not that patents are inherently an instrument of monopoly. They are not. They are the most effective weapon the independent and the entrepreneur can use against entrenched monopoly. It is, merely, that *when any branch of the law becomes so difficult, so uncertain in its operation, and, therefore, so expensive, that the poor man cannot afford justice, it has degenerated into an instrument of oppression by entrenched wealth.*

The decision of the court below would add greatly to the already much too heavy burden of expense imposed upon the inventor as the price of an effective patent and to the expense and uncertainty of patent litigation. Only the wealthy established concern could afford to use patents. If, after suing the infringer in good faith and after all the delays and expense of litigation, the patentee should receive a decision disagreeing with his own construction of his patent and holding his claim invalid, the patentee, unless he were so fortunate as to have a subsidiary claim well drawn to the particular contingency, would have to go back and start all over with a new application in the Patent Office and he could not recover on any new claim for any infringement occurring before the grant of his reissued patent. (R. S. 4916, U. S. C., Title 35, sec. 64.) If, as in the present case, he should seek voluntarily to clarify the issues,

he would have to delay bringing his action for the many months—and often years—required for prosecution of an application in the Patent Office. When he would finally have his reissue patent and bring his suit, not only would he be precluded from redress for past infringement; but he might reasonably expect that the defendant may come forward with additional prior art not before available to the patentee and which would again send him back to the Patent Office for a second reissue.

But not only does this excessive expense make patents unavailable to the entrepreneur whom it was intended to encourage; it destroys his chance of defending against a strongly held patent. He cannot afford to have satisfactory investigations made as to his right to adopt new products and practices if he must pay skilled patent attorneys to study thousands of claims multiplied by the need to forestall each possible fact and combination of facts which might affect validity; and he cannot afford to proceed in the face of the uncertainties which the decision below would prevent him from having promptly determined.

The interpretive disclaimer is the mechanism by which the courts are enabled to give prompt and substantial justice in each case—to leave the parties with a determination of their rights on which they can act in future conduct of their business. The court below has disqualified itself from deciding the issues *inter partes* until the Patent Office has first decided them in an *ex parte* proceeding. Not only does this leave the patentee with no redress for infringement until after the reissue and send him back for repetition of both the *ex parte* and *inter partes* proceedings as often as new and significant evidence may be found by the defendant; but it also leaves the defendant with no effective means of determining his rights.

Under the law as it existed prior to the decision below a manufacturer, knowing of facts which in his opinion made a patent claim invalid, could, by declaratory judgment, obtain final determination of his right to manufac-

ture a given article or to use a given process or material. So long as the decision below shall stand, the court in such an action can only find the claims invalid and cannot determine the real issue of whether the manufacturer is proceeding within his rights or is infringing upon the patentee's rights. The court can only give the unsatisfactory answer, "Wait and see what the Patent Office may do in an ex parte reissue proceeding!" And thus the manufacturer is put back where he was before any litigation began and certainly no better off than he would have been if the interpretive disclaimer had been available to the patentee as intended by R. S. Secs. 4917 and 4922 (U. S. C., Title 35, Secs. [illegible] and 71), i. e., he must decide for himself what is the patentee's real invention which may be sustained by the Patent Office in the granting of a reissue and by the courts in subsequent litigation. It will be little comfort to him to know that the patentee may have to face additional costs to obtain a reissue patent, if he knows that his own resources may be exhausted by the costs of litigation before a reissued patent could be adjudicated, or that a possible judgment for infringement damages would break him. For him uncertainty is equivalent to absolute validity. Only the wealthy, powerful competitor can afford to face those risks.

If, instead of forcing the patentee back into the Patent Office, he is allowed to narrow his claim by disclaimer then the scope of the patent is determined promptly in the same litigation; the defendant knows where he stands and can chart his course accordingly. It is this certainty, not endless delay, which the entrepreneur needs.

Proper Function of Patent System

The interests of the entrepreneur have been emphasized above because it is he whom the patent system is designed to encourage. Patents have always been looked upon, and historically have proven to be, one of the greatest instruments of democracy. The patent and copyright system has

done much to make democracy strong by bringing to positions of power and leadership those men—whoever they may be and in whatever classes—who have the genius to make, or the foresight and daring to develop and bring into use, new things. It offers to this generation and to every generation a frontier of virgin territory that can and should play the same part for modern democracy that our land frontiers of the West have played in the history of our democracy. It gives to the young pioneer a field in which he may exercise his full skill, intelligence and daring without encroachment by established competitors.

No Grant of Monopoly

But there is a very significant difference between land patents given to the pioneers of the West and the patents for invention given to modern industrial pioneers: The land patent carved something out of the public domain and gave it to a private individual and his heirs and assigns forever. A patent for an invention takes nothing from the public domain, instead it adds to it. (Cf. Walker on Patents, Deller's Edition, § 6, pp. 24-27.)

A patent for an invention is not a grant; it is a contract (Ibid, p. 27). When the inventor creates something which never before existed, he has something which no man, nor even the state, can take away from him—a thought. If he chooses to keep it as a thought and to let it die, no man can gainsay him. If he chooses to develop it and profit from it by use in secret, it is his right by common law; and the courts will lend their aid to preserve his secrecy against theft or violation of confidence. In this way he may use it and profit by it for life and it may be forever lost to mankind when he dies; or he may pass it on so that it continues exclusively for the benefit of his successor-confidant. But this will follow only so long as the secret is kept. To keep a secret is difficult; so the Government by its patent law proposes to the inventor—"If you will divulge your

secret and instruct the public in the art of practicing your invention, we will assure you the same exclusive use you could have had if you had effectively kept your secret, but only for a short term of years". If he should keep his secret well his exclusiveness would last much longer than the offered term, but if his secret should leak out or be rediscovered, then his exclusiveness would be short-lived. Most inventors choose to accept this proposal. The Government then has a contractual obligation from which it can be absolved only upon proof of fraud or mistake.

Patents Not Reward to Inventors

Another very important, but often overlooked, fact about the patent law is that it is not designed to reward inventors. That may sound heretical; it is not. The basic provision in the Constitution says nothing about rewarding inventors; it merely gives to Congress the power

> " . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries" (Art. I, sec. 8).

That is no reward to the inventor. So long as he kept it to himself the inventor already had the exclusive right to his invention; it could not be taken away from him. The purpose of the law is to obtain something of value *for the public;* the reward comes only when the inventor, or someone whom he interests in his invention, promotes the progress of a useful art. Only then does his exclusive right attain real value.

The garret inventor needs no stimulus to invent and his invention does no public service deserving of reward. Inventing is fun—a kind of solitaire—a game which one who has that kind of a mind plays with himself. What does require the stimulus of promised reward is the hard work and persistence through seemingly endless disappointments

and the risk of money as well as time, all of which must be invested before an invention is of any real value to the public. The idea that a collodion solution could be drawn out into a thread like a spider's web and spun into silk may have been an interesting speculation enjoyed by many people, but the thought clothed nobody in finery until, after much investment of capital, and enduring labor interspersed with pain of many disappointments, the inventor and his backers, the entrepreneurs, gave birth to a new industry, the rayon industry.

The progress of science and the useful arts today is mostly promoted by strong companies having large highly trained technical staffs and fully equipped laboratories; but that should not blind us to the importance of the independent inventor and entrepreneur. The big companies are dominant in research and development primarily because of the threat of competition.

This court may judicially note the notorious facts that the dominant factor in the automobile industry all but died from a static product and was able finally to catch up with competitors only by resorting to research and development, and that that company had always been antagonistic to patents.

The power of bigness is enough to maintain dominance in a static industry; but the weapon of patented research and invention is the sling-shot in the hands of David. Monopolies turn to research and patents for defense against inventors, meanwhile looking on the patent system as a nuisance and a constant threat. They must maintain big technical staffs and laboratories and must patent and develop the results of research and bring new developments into use as the only way to be sure that an independent may not get there first and crowd them out of the dominant position. The public gains by the resulting progress. But in spite of all activities by dominant concerns, we still have independents forging ahead into new industries, our radio industry, our rayon industry, our plastics industry, our

aircraft industry, have all brought into the roster of recognized leaders the names of independent entrepreneurs who staked their fortunes on patented developments.

Were it not for patents and the stimulus to development of inventions which the granting of patents produces, the monopolies could well afford to give up their laboratories and merely to copy competitors' innovations. With the advantages of bigness and freed from the costs of research and development, they could always undersell the smaller competitor and the entrepreneurs of a new industry. So the public would lose, industries would become static, and this democratic road to the top would be closed.

It is by keeping open and policed the high road for the development of new inventions into new industries that "progress of science and useful arts" is achieved. The courts should, therefore, be jealous to guard the rights of the inventor and the entrepreneur and the minor competitors (however big in themselves) who are contending with the dominant producer, and to keep the costs of such protection within the reach of those who need all their resources for such development. If this is done patents may become the most effective and the most just means of controlling monopoly.

Need for Constructive Reform

Investigations and statistics, both Congressional and private, will often miss these facts because they see the industrial giants. They attack the problem of infant mortality in industry from the point of view of "preventing cruelty to children" instead of studying how to make infants healthier and better able to survive in a cruel world. Yet for every infant saved by the prevention of cruelty, millions have been saved by the study of nutrition and medicine.

Too much of our recent legal reform has been of the anti-trust variety—for prevention of cruelty by the big brutes. What is needed now is more emphasis on a healthy

diet of prompt and inexpensive justice and certainty on which the infants of industry—the entrepreneurs who are pioneering up from the ranks—can thrive.

Conclusion

In view of the public interest involved, your petitioner begs leave to present these considerations, as a part of his duty as an officer of this Court, by a brief Amicus Curiae.

Respectfully submitted,

TRUMAN S. SAFFORD,
Attorney.

SUPREME COURT OF THE UNITED STATES.

No. 720.—October Term, 1941.

Milcor Steel Company, Petitioner,
vs.
George A. Fuller Company, Neff Lathing Company, Inc., and Conver Steel & Wire Company, Inc.

On Writ of Certiorari to the United States Circuit Court of Appeals for the Second Circuit.

[April 27, 1942.]

Mr. Justice Black delivered the opinion of the Court.

This is a suit brought in the District Court for infringement of two claims of a patent issued to one Holdsworth and assigned to the petitioner. One defense pleaded by the respondents was that Holdsworth was not the original inventor. When a patentee, "through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention . . . . has claimed more than that of which he was the original or first inventor . . . ", Rev. Stat. § 4917, 35 U. S. C. § 65, preserves for him or his assignee "all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented." The method prescribed for saving the patent in part is "disclaimer of such parts of the thing patented" as the patentee or his assignee "shall not choose to claim." After the respondents answered, the petitioner filed disclaimers in the patent office with respect to the two claims in suit, purporting to narrow their scope in accordance with the statutory authorization. The defendants then moved for summary judgment on the pleadings pursuant to Rules 12(c) and 56(b) of the Federal Rules of Civil Procedure. Their grounds, among others, were that the revised claims added new elements not recited in the original ones; and represented an effort to give the old patent a new scope not previously contemplated and never passed upon in the light of the prior art by the patent office. The District Court found that the disclaimers did import new elements not included in the original claims and held that they rendered the claims invalid, relying upon our decision in *Altoona Theatres v. Tri-Ergon Corp.*, 294 U. S. 477. Accordingly, it entered sum-

mary judgment for the defendants. The Circuit Court of Appeals affirmed. 122 F. 2d 292.

As we read the opinion of the court below, it affirms the proposition that where a disclaimer attempts to add a new element to a claim the disclaimer is invalid even though it may also make the revised claim narrower than the original. We granted certiorari because of alleged conflict with decisions on the question in other circuits.[1]

The patent in suit here is for a wall, to be used as a partition between rooms or on the inner side of the walls of the building itself. The necessary parts are a piece of metal to be fastened to the ceiling; another to be fastened to the floor; upstanding channel iron supports running between the top and bottom members; metal lathing to be fastened by wires to the skeleton wall in order that plastering may be supported.

The specifications describe and drawings illustrate (1) a top angle iron member with a perforated surface or flange hanging downward so as to fit into slots at the top of the upstanding irons; (2) recesses in the base member providing a snug fit for the bottom part of the upstanding channel irons. The two claims in controversy are printed in the margin.[2] As the courts below pointed out, it is these claims, not the specifications, that afford the measure

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[1] See, *e. g.*, Payne Furnace & Supply Co. *v.* Williams-Wallace Co., 117 F. 2d 823; Cincinnati Rubber Mfg. Co. *v.* Stowe-Woodward, Inc., 111 F. 2d 239.

[2] "6. A wall construction for a room having a floor and a ceiling, said wall construction including a base member and a ceiling member, said wall construction also including upstanding wall-supports whose height is less than the maximum vertical distance between said base member and said ceiling member, said upstanding wall supports being located between said base member and said ceiling member; said wall supports being vertically movable relative to said base member and to said ceiling member when said wall supports are assembled with said base member and said ceiling member, *and means operative to prevent any substantial tilting movement of said wall supports from their predetermined upstanding position.*

"7. A wall construction for a room having a floor and a ceiling, said wall construction including a base member and a ceiling member, said wall construction also including upstanding wall-supports whose height is less than the maximum vertical distance between said base member and said ceiling member, said upstanding wall supports being located between said base member and said ceiling member, said wall supports being vertically movable relative to said base member and to said ceiling member when said wall supports are assembled with said base member and said ceiling member, *said base member and said ceiling member being shaped to provide means which are operative to prevent any substantial tilting of said wall supports from their predetermined upstanding position.*"

Italics have been added to mark those portions in which the two claims differ from each other.

of the grant to the patentee.[3] "Out of all the possible permutations of elements which can be made from the specifications he reserves for himself only those contained in the claims." 122 F. 2d 292, 294. The foregoing features appearing in the specifications are not set out in the claims themselves; the claims do not indicate in any way that these features were essential parts of the combination for which the patent was issued. On the contrary, Holdsworth asserted that his specifications in general showed only a "preferred embodiment" of his invention, and with respect to the ceiling member in particular, stated: "I do not wish to be limited to an angle iron for completing the top of the metal construction."

The disclaimers, however, purported to make these two features essential parts of the claimed combination. One disclaimer substituted for part of one of the original general claims a description of a "ceiling member [which] comprises a vertical depending perforated flange, one side of which is overlapped by metal lathing"; and the other disclaimer substituted for part of another original general claim a description of a "base member . . . composed of a longitudinal strip having recesses to receive the lower ends of the webs of channel wall supports, the flanges of the channel wall supports overlapping the base members adjacent the recesses." Limiting ourselves as we must to the original claims to determine the nature of the combination covered by the patent when it was granted, and comparing that combination with the one purportedly embodied by the claims after the disclaimer, we can only conclude that the revised patent includes new elements which were not present in the original.

The petitioner's argument is that the statute authorizes any disclaimer which actually narrows the claim, and that its disclaimer would have the requisite narrowing effect because it would restrict the claims to cover the combination only when the features described in the disclaimers were present.

But in *Altoona Theatres* v. *Tri-Ergon Corp.*, *supra*, 489-490, the test which the petitioner argues for here was rejected. Although this Court recognized that an effect of the disclaimer in controversy in the *Altoona* case was "in one sense to narrow the

[3] Rev. Stat. § 4888, 35 U. S. C. § 33, requires that the applicant for a patent "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery." See Paper Bag Patent Case, 210 U. S. 405, 419; Mahn v. Harwood, 112 U. S. 354, 360-361.

claims", it concluded that the disclaimer statute "does not permit the addition of a new element to the combination previously claimed whereby the patent originally for one combination is transformed into a new and different one for the new combination."

The Holdsworth patent was for a structure composed of a combination of familiar elements. If there was novelty it consisted in the combination. "A combination is always an entirety. In such cases, the patentee cannot abandon a part and claim the rest, nor can he be permitted to prove that a part is useless, and, therefore, immaterial. He must stand by his claim as he has made it. If more or less than the whole of his ingredients are used by another, such party . . . has not used the invention or discovery patented. With the change of the elements the identity of the product disappears." *Schumacher* v. *Cornell*, 96 U. S. 549, 554. This Court has explicitly recognized that the disclaimer statute cannot be invoked to justify such a change. *Vance* v. *Campbell*, 1 Black 427, 429. And here, as in the *Altoona* case, the revised claims change the combination set out in the original claims. The disclaimers do more than delete a "distinct and separable matter . . . 'without mutilating or changing what is left standing"; they change the character of the claimed invention and are therefore unauthorized by the disclaimer statute. *Hailes* v. *Albany Stove Co.*, 123 U. S. 582, 587.

If an alteration of one of the essential elements of a claimed combination were permissible at all it would be under the reissue statute, Rev. Stat. § 4916, 35 U. S. C. § 64, which grants rights only from the date of reissue and after consideration by the patent office. *Altoona Theatres* v. *Tri-Ergon Corp.*, *supra*, 491. To permit such substantial alterations under the disclaimer statute which, where applicable, gives effect to the revised claims from the date of the original issue without any consideration by the patent office would be contrary to the policy of the patent laws. In the words of Mr. Justice Bradley, it would permit "a man . . . . by merely filing a paper drawn by his solicitor, [to] make to himself a new patent." *Hailes* v. *Albany Stove Co.*, *supra*, 587. Cf. *Brooks* v. *Fiske*, 15 How. 212, 219. It would also retroactively create possibilities of innocent infringement where no one would reasonably have suspected them to exist.

The courts below properly decided that the attempted disclaimers here invalidated the claims in controversy. Accordingly, the judgment is

Affirmed.